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EXAMINER

RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/700,184

Applicant(s)

PAPING, MAX G.

Examiner

Stevan A. Resan

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-14-2003 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 9,11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are deemed indefinite in that they require an "edge zone" which appears to contradict the requirement that the size and shape of all three layers is the same.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4,8,14,18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nesbitt US 5549938. See Fig 1,8 ;Col 4 lines 7-19,27-31; Col 5 lines 2, 21-26,41-65.

With respect to the limitation "reflective having signaling properties", the examiner broadly interprets this to include the patterns of Nesbitt since the light reflected would have different properties than the incident white light hitting the pattern. With respect to claim 4 a vinyl sheet (13) is broadly considered a "non-woven material".

7. Claims 1-4,12,14,18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sano US 4663874. See Fig 2, Col 1 lines 11-15; Col 2 lines 63-64, Col 4 lines 7-8

With respect to the limitation "reflective having signaling properties", the examiner broadly interprets this to include an "advertising message". Note that claim 1 is in the alternative i.e. that the flexible permanent magnetic layer may be the same as the carrier first layer which is the case in Sano et al.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Nesbit or Sano et al as applied to claim 1 above, and further in view of Karalus US 3078183.

Neither Nesbitt nor Sano et al disclose that the flexible permanent magnetic layer is anisotropic. However, Karalus teach the orientation of the particles in a magnetic tape. Therefore it would have been obvious to one of ordinary skill in the art to orient the magnetic particles in the elastomeric magnetic layers of Nesbit or Sano et al in order to form rolls which would stay tightly rolled in the production environment and which would resist demagnetization in storage. (See Col 3 lines 33-40 and Col 4 lines 41-44)

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Nesbit or Sano et al as applied to claim 1 above, and further in view of Darango US 5226792.

Neither Nesbitt nor Sano et al disclose the securing of a laminate by clampingly securing between a door or window of a vehicle. However Darango teaches this procedure. Therefore it would have been obvious to one of ordinary skill in the art to use the procedure to prevent theft of the sign as taught by Darango (Col 2 lines 43-44).

11. Claims 6,7,9,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt or Sano et al as applied to claim 1 above, and further in view of Clark US 2599047.

Neither Nesbitt nor Sano et al disclose an edge feature having aerodynamic tapering or without permanent magnetization. However Clark teaches these features (See Fig. 2,3.) It would have been obvious to one of ordinary skill in the art to employ

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these features in the lamination of Nesbitt or Sano et al in order to facilitate removal when required, and enhance adhesion when a vehicle was in motion. Also note that Clark teaches that the markers may be fluorescent or luminescent. Note Nesbitt discloses prior art camouflage systems having differing reflective properties for different incident light wavelengths. (Col 2 lines 18-25)

12. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt or Sano et al as applied to claim 1 above, and further in view of Freedman US 4713273.

Neither Nesbitt nor Sano et al disclose coextrusion of at least two Layers. However Freedman teaches the coextrusion of layers for signage. It would have been obvious to one of ordinary skill in the art to co extrude at least two of the layers of either Nesbitt or Sano et al in order to reduce cost. (See Freedman col 1 lines 1-12; Col 2 lines 21-25; 56-68.)

13. Claims 5, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt as applied to claim 1. Nesbitt discloses that the layers may be glued as one of several means of attachment. (Col 5 line 25). Substitution of equivalents requires no express motivation since Nesbitt recognizes the equivalency.

In re Fount 213 USPQ 532 (CCPA 1982); In re Siebentritt 152 USPQ 618 (CCPA 1967); Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co. 85 USPQ 328 (USSC 1950).

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14. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Applicant's arguments filed 4-14-03 as they apply to the present claims and rejections have been fully considered but they are not persuasive.

Applicants traverse the rejection based upon Sano et al arguing that Sano does not teach or suggest a laminate having a light active second layer that is reflective and has signaling properties. However the object of the flexible laminate of Sano is to have an advertising message on the outer continuous surface. It would have been obvious to one of ordinary skill in advertising a sign should attract attention and therefore have special features to attract attention at night or day such as reflecting or luminescent properties.

Applicants argue that Bump Jr. et al does not teach or suggest a laminate since the banner has pockets in which the magnets are embedded. However note Col 4 lines 15-17 "Other known means of fastening or attaching the magnet can be done such as glueing the magnet to the fabric. Symbols may also be glued to the fabric (thus forming a laminate). The magnets of Bump Jr. are not specified as rigid and thus also encompass flexible magnets. It would have been obvious to one of ordinary skill in the art to use flexible magnets due to their low cost.

Applicants argue that Carroll does not teach or suggest a laminate or a magnetic layer which is the same size and shape as the reflective layer. However Sano et al has already suggested this feature in figures 2 and 3.

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Applicants argue that Clark uses a rigid magnet that is not flexible. However Clark has been used for teachings of the symbols that may be placed on the outer surface of a magnetically attachable sign namely those that "glow" which the examiner broadly interprets as encompassing a "luminescent sign".

Applicants argue that Darango discloses a sign with magnets sewn into the sign and is not a laminate. However the examiner has applied this reference specifically for teaching that a sign may be clampingly secured between a vehicle door or window.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718


STEVAN A. RESAN
PRIMARY EXAMINER